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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,597	09/26/2001	Daniel S. Gluck	GLU-01	3506

7590 04/26/2004

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EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/965,597	GLUCK ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim rejection under 35 U.S.C. 112 first paragraph has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-20, 33 and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17-20 and 39-42. The term "or" makes **claims 17-20 and 39-42** indefinite.

Also, **claims 17-18 and 39-40** are confusing, because:

the term "the database" lacks antecedent basis;

it is not clear what method steps does the term "lobbying activity" actually contemplate.

Claim 33 is confusing, because **claim 33** includes two period signs (".").

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22, 47 and 49 are rejected under 35 U.S.C. 101 because the claimed method for energy consulting does not recite a limitation in the technological arts. The independently claimed steps of: collecting data on energy usage from a customer and energy system supply data; calculating and reporting the availability and costs of energy systems; receiving a commitment from the customer to purchase at least one energy system; arranging the purchase and installation of the purchased energy system, are abstract ideas which can be performed mentally without interaction of a physical

structure. The method step "collecting data on energy usage from a customer" may be understood as merely making notes related to said usage; and method step "arranging the purchase and installation of the purchased energy system" may be understood as calling a customer to set up a date for signing a contract for purchasing a system. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).*

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2, 5-8, 10-12, 15-16, 22-24, 27, 29-30, 32-34, 37-38, 44 and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru et al. (US 5,432,710) in view of Dworkin (US 4,992,940).

Ishimaru et al. (hereinafter Ishimaru) teaches energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising:

Independent Claims.

Claims 1, 23 and 47-49. Collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer (column 10, lines 14 – column 11, line 12).

However, Ishimaru does not teach arranging the purchase and installation of energy system.

Dworkin teaches a method and system for automated selection of equipment for purchase, wherein a user specifies desired specifications and the system searches a database to retrieve products within the selected category at the best available price (column 2, lines 20-48).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru to include arranging the purchase and installation of energy system, because it would allowed customer to chose his own power generating equipment to fulfill the objective of optimizing energy cost, energy consumption and emission of pollutants.

Dependent Claims.

Claims 2, 8, 24 and 30. Ishimaru et al. and Dworkin teach said method and system, in which the data on energy usage comprise data on historical or anticipated electric power usage and energy generation preferences, including solar cells, fuel cells and wind power generators (Ishimaru et al. column 9, lines 27-29; column 10, lines 22-27).

Claims 5, 7, 27 and **29.** See **claim 1.**

Claims 10-11 and **32-33.** See **claim 1.**

Claims 12 and 34. Said method and system, wherein communication between the customer and the system is provided via electronic mail, and wherein the customer is kept informed of changes or new developments (Dworkin; column 3, lines 12-14; column 4, lines 21-22).

Claims 15 and **37.** See **claim 1.**

Claims 16 and **38.** Said method and system, including notifying potential buyers about the new products obviously indicates marketing of new equipment (column 3, lines 12-14).

Claims 22 and **44.** See **claim 1.**

Dependent claims 3-4, 6, 13-14, 17-18, 25-26, 28, 35-36 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru et al. and Dworkin.

Claims 3 and 25. Ishimaru and Dworkin teach collecting energy supply data from a plurality of suppliers (Ishimaru; column 10, lines 14 – column 11, line 12).

Information as to *the content* of said energy supply data is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Ishimaru and Dworkin would be performed the same regardless of *the content* of said energy supply data.

Claims 4, 14, 26 and 36. Ishimaru et al. and Dworkin teach said method and system, in which the data on energy usage comprise data on historical or anticipated electric power usage and energy generation preferences, including solar cells, fuel cells and wind power generators (Ishimaru et al. column 9, lines 27-29; column 10, lines 22-27).

However, Ishimaru et al. do not specifically teach availability of sunlight, availability of hydrogen-based fuels and availability of wind.

Official notice is taken that it is well known that utilization of wind power generators and solar cells is possible if there is adequate amount of this resources.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru et al. and Dworking to include data on availability of sunlight, availability of hydrogen-based fuels and availability of wind, because the feasible utilization of said devices is only possible with adequate availability of said resources.

Claims 6 and 28. Ishimaru and Dworkin teach the energy generation system installed at the customer premises (Ishimaru; column 8, lines 3-8; column 9, lines 27-29). Information as to *the type of energy generation system* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claims 13 and 35. Ishimaru and Dworkin teach collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer (Ishimaru; column 10, lines 14 – column 11, line 12). Information as to the *need to visit the customer's site* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claims 17-18 and 39-40. Ishimaru and Dworkin teach optimizing energy consumption and emission of pollutants from economic and national points of view (Ishimaru; column 3, lines 34-36).

However, Ishimaru and Dworkin do not specifically teach organizing the customers to advocate politically for regulatory changes.

Official notice is taken that it is well known to advocate for non-polluting technologies due importance of reducing dangerous for human health environmental contamination.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru and Dworking to include organizing the customers to advocate politically for regulatory changes, because it would allow to reduce environmental contamination thereby decrease the danger of human health.

Claims 18 and 40. Ishimaru and Dworkin teach optimizing energy consumption and emission of pollutants from economic and national points of view (Ishimaru; column 3, lines 34-36).

However, Ishimaru and Dworkin do not specifically teach organizing the customers to advocate politically for regulatory changes.

Official notice is taken that it is well known to advocate for non-polluting technologies due importance of reducing dangerous for human health environmental contamination.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru and Dworking to include organizing the customers to advocate politically for regulatory changes, because it would allow to reduce environmental contamination thereby decrease the danger of human health.

Dependent claims 9 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru and Dworkin in view of Ardalan et al. (US 6,396,839).

Claims 9 and 31. Ishimaru and Dworkin teach all the limitations of **claims 9 and 31**, exept that the data on energy usage is collected interactively from an Internet Web site.

Ardalan et al. (hereinafter Ardalan) teach a method and system for remote access to electronic meters using a TCP/IP protocol suite, wherein the data on energy usage is collected from an Internet Web site (column 4, lines 50-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru and Dworking to include that the data on energy usage is collected from an Internet Web site, because the Internet is the largest existing available network, and using the Internet would be less costly then installation of the dedicated network.

Claims 21, 43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru and Dworkin in view of Bezos et al. (US 6,029,141).

Independent Claims.

Claims 45 and 46. Ishimaru and Dworkin teach all the limitations of **claims 45 and 46**, except for encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others.

Bezos et al. (hereinafter Bezos) teaches a method and system for Internet-based customer referral arrangement, wherein, if the customer selects a referral link, the commission is automatically credited to an account of the referring associate (column 1, line 62 – column 2, line 18).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru and Dworking to include encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others, because it would allow to increase sales and revenues without adequate spending for advertisement.

to include encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others, because it would allow to increase sales and revenues without adequate spending for advertisement.

Dependent Claims.

Claims 21 and **43.** See **claims 45** and **46.**

Depenedent claims 19-20 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishimaru, Dworkin and Bezos.

Claims 19-20 and 41-42. Ishimaru, Dworkin and Bezos teach all the limitations of **claims 19-20 and 41-42,** including optimizing energy consumption and emission of pollutants from economic and national points of view (Ishimaru; column 3, lines 34-36), wherein said Web site is promoted (Bezos; column 1, line 62 – column 2, line 18), except specifically teaching using the benefits to society of non-polluting energy system

to facilitate organizing the customers, politicians and celebrities to generate unpaid publicity of said website.

Official notice is taken that it is well known to advocate for non-polluting technologies due importance of reducing dangerous for human health environmental contamination.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishimaru, Dworking and Ardalan to include organizing the customers, politicians and celebrities to generate unpaid publicity of said website, because it would allow to reduce environmental contamination thereby decrease the danger of human health.

Response to Arguments

Applicant's arguments filed 1/30/04 have been fully considered but they are not persuasive.

In response to applicant's argument that prior art relates only to extremely large industrial power generators, examiner points out that there is not teaching in Ishimaru that limits the patented invention only to extremely large industrial power generators. In contrast, Ishimaru teaches that the patented invention relates to energy supply system for supplying energy in an optimal condition to energy consumers for consumption of heat and electricity in heating water, cooking, lighting, cooling and heating spaces, as well as operating equipment for other purposes (column 1, lines 8-13). Also, Ehlers et al. (US 5,924,486), cited as prior art in the first Office Action, specifically teaches a residential environmental condition control system, wherein different types of energy sources (such as an electric, fuel cell or photo-voltaic system) may be utilized (column 1, line 6; column 22, line 59).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ishimaru discloses a method and system wherein energy system, installed for a customer, is optimized from economic and national points of view (column 3, lines 34-36). Dworkin discloses selecting and purchasing equipment by the customer, wherein said equipment is optimized from economy and technological desirability points of view (column 2, lines 20-48). The motivation to combine Ishimaru with Dworking would be the ability of customer to participate in selecting the purchased equipment so that said purchased equipment would be optimized not only from economic and national points of view, but would also include customer-specified desired technical characteristics, and would be purchased at the best available for customer price (column 2, lines 20-48).

In response to applicant's argument that Ardalan does not disclose the agreement of the customer to the proposal offered by the website, examiner stipulates that Ardalan was applied for collecting interactively the data on energy from the Internet Web site (column 4, lines 50-53). The motivation to combine Ishimaru and Dworking with Ardalan would be the advantage of using an existing largest network available without necessity to develop a dedicated network (See discussion above). Also, any information posted on the Internet is almost instantly available to every Internet user.

In response to applicant's argument that Bezos does not show advocacy for regulatory changes, examiner points out that Bezos was applied for encouraging the customer to contribute contact information of others via the website in return for a commission on sales resulting from such others (column 1, line 62 – column 2, line 18). The motivation to combine Ishimaru and Dworking with Bezos would be increase of sales and revenues without adequate spending for advertisement (See discussion above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

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